REMARKS/ARGUMENTS

Reconsideration and allowance of the application as amended is respectfully requested.

Summary of Changes:

1. Claim 1 has been modified for clarity.

2. Claim 12 has been corrected as required by the Examiner.

3. Claim 18 has been corrected as required by the Examiner.

4. Claims 14 and 19 have been modified in response to the Examiner's rejection of those two claims under 35 U.S.C. §112.

5. Claims 9, 14, 16 and 19 have been modified in response to the Examiner's rejection of those claims.

6. No new matter was added to the claims, but the terminology of the claims was made to conform to terminology used in other parts of the application.

Remarks:

7. The Examiner rejected claim 12 and claim 18, and those claims have been modified in accordance with the Examiner's suggestion.

8. The Examiner rejected claims 14 and 19 under 35 U.S.C. §112 first paragraph. Those two claims have been amended to remove material which the Examiner felt had insufficient support in the specification. The changes made to claims 14 and 19 are based upon information originally disclosed in the application in paragraphs [0035] and [0036].

9. The Examiner rejected claims 9, 14, 16 and 19 under 35 U.S.C. §112 second paragraph, for antecedent basis and clarity problems. Revised claims 9, 14, 16 and 19 address those problems and put the claims in condition for allowance. No new matter has been added.

10. The Examiner has rejected claims 1 and 5 as being anticipated under §102(e) by U.S. Pat. No. 6,609,106 to Robertson.

11. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.

12. Further, to constitute an anticipatory reference, the prior art must contain an enabling disclosure. Chester v. Miller, 906 F.2d at 1576 n.2, 15 U.S.P.Q.2d at 1336 n.2 (Fed. Cir. 1990); see also Titanium Metals Corp. of America v. Banner, 778 F.2d at 781, 227 U.S.P.Q. at 778 (Fed. Cir. 1985). A reference contains an enabling disclosure if a person of ordinary skill could have combined the description of the invention in the prior art reference with his own knowledge of the art to have placed himself, and thereby the public, in possession of the invention. In re Donohue, 766 F.2d 531, 533, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985); In re Sheppard, 339 F.2d 238, 242, 144 U.S.P.Q. 42, 45 (C.C.P.A. 1964).

13. We do not believe that Robertson has all the features of claim 1 and 5, and any disclosure in Robertson of similar features is not an enabling disclosure. Robertson does not contain an enabling disclosure because there is no disclosure of possible purchases being presented to a user for possible purchase by the user and no system for selecting items for display based on user preferences and interests and other characteristics.

14. Robertson is an Internet based version of the traditional gift registry concept. The traditional gift registry is for instance, when a person such as a soon-to-be bride goes to a department store and creates a list of gifts that are available in the store that the bride would like to receive. The existence of a gift registry is communicated to potential gift buyers, and people can go to that department store and select a gift that they know the bride will appreciate, and they can tell if that gift has already been taken by another gift giver.

15. Robertson takes this concept and puts it in the context of the Internet. The user still selects specific products that they would like to have, but since it is Internet-based, they can select products from more than one store. In fact the sources of the gifts may not be brick and mortar stores but they may be other sites which offer the products at a discount. The events for which gift registries can be set up or expanded beyond the bridal gift registry could be other events such as birthdays, Christmas and many others. However, in all variations of Robertson's system, it is a gift registry system. The user selects specific gifts, gift purchasers can then go to the list and purchase those specific gifts and have them sent to the gift recipient, and the list will indicate that a certain gift is "taken."

16. In column 2, lines 55 through 58 of Robertson, the patent states that "the major benefit to the individual is that they can store a complete "Wish" list of all items of interest in a central location that others may access for gift purchases and do so in a faster method than previous inventions."

17. In column 10, lines 3 through 7, Robertson states that "the Service Provider maintains a list of items of interest on behalf of the user and allows the user to either purchase these items or have them transferred to the on-line gift registry to be added to the user's Wish list." In column 10, line 42, the system of Robertson is compared with existing systems and in item 2, it is stated that "the user is able to tag items of interest while shopping at SP sites and have the SP transfer the items to their centralized "Wish" list on their behalf." And at #6 in the same page, column 10, line 50-56, purchasers can "filter items in the registrant's "Wish" list based on different criteria such as re-seller and costs among others."

18. All explanations of the Robertson system indicates that the user selects specific items to be placed in his "Wish" list. This is different than the system of the invention. In the system of the invention the user would typically not specify specific products. Rather, they would specify general information such as interest in hobbies, interest in certain types of products, an income bracket, a geographic location, interest in certain types of products for certain gift recipients, such as a spouse, and other things which generally but not specifically indicate to the system what types of product should be presented and when they should be presented. When the products are presented to the user, they fit the general interest of the user. They might be hiking equipment, ski clothes, jewelry in the price range of $100 - $150, business software, history books, or other items which fit the general profile that the user has supplied. These can include items for a spouse or presents for other people which might include jewelry, flower arrangements, articles of clothing from various manufactures, etc. None of these articles are specifically selected by the user. Rather they are selected by the system based on the merchant submissions and the user's interest and preferences, price range and age. Thus, the gift registry of Robertson is different than the product selections and presentation system of the current invention. Claim 1 has been modified to further highlight these differences, and differentiate claim 1 more clearly from the invention of Robertson.

19. Claims 2, 4, 6-7 and 12 are rejected under 35 U.S.C. §103(a) as being patentable with Robertson combined with U.S. Pat. No. 5,991,771 to Falls, et al.

20. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves of in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP § 706.02(j).

21. We do not feel that the Examiner has made a prima facie case, because there is no suggestion to combine the patents cited, and no reasonable expectation of success.

22. There is no motivation whatsoever provided by Robertson and Falls to provide a system like that of the invention. Each of these patents is complete and solves a particular problem, whereas a different problem is solved by the system of the invention. The combination of Robertson and Falls is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicant's claims. In particular, the references do not disclose, teach or suggest a system whereby merchants can present items or services to a shopper based on the shoppers interests, preferences, characteristics, and in a way that the shopper can interact with the product offering while offline.

23. To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. *W.L. Gore & Assoc. v. Garlock, Inc.* 721 F.2d 1132, 1138, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

24. Falls, et al., is a file protocol in which two computers are linked together and files on the system computer are downloaded to the portable computer. The files downloaded are part of a database, and the system manager would determine which portions of the database structure would be transferred to the portable computer. The user can then disconnect his portable computer and work on the data as if he were still connected to the system computer. Thus, the portable computer presents a virtual network to the user. When the user reconnects his portable computer to the system computer, the files are synchronized and any changes made by the user are updated to the system files.

25. With this updating capability between a base computer and a portable computer, the system of Falls, et al., is similar to the updating capability of a Palm Pilot. With a Palm Pilot or other PDAs, the information between one computer and another, or between multiple computers, is updated by a process called "hot syncing." Thus, the changes made on a desktop computer at work are transferred to the hand-held PDA and the address list for instance of the PDA is updated. When the PDA is synchronized with the home computer, the home computer is also updated with the most current information. This appears to be what Falls, et al., achieves with his patent.

26. As with updating a Palm Pilot, Falls, et al., refers to computers which are disconnectable from the system, but which include a database manager (Col. 7, Lines 16-19). Falls, et al., later notes that "replicas 56 at different locations (namely on separate computers 40) may temporarily contain different values for the same variable or record." Such inconsistencies are temporary because changes in value are propagated throughout the replicas by the invention. Thus, if the changes to a particular variable or record are infrequent relative to the propagation delay, then all replicas 56 will converge until they contain the same value for that variable or record (Col. 7, Lines 44-53).

27. The system described above is equivalent to updating information between a Palm Pilot and a work computer or home computer. Falls, et al., refers to "syncupdate requests" and the "replicas being resynchronized" in a manner very consistent with this synchronization of databases between a Palm Pilot and a computer.

28. However, this synchronization activity is not the same as the updating of information step of the system of the invention. In the synchronization program of Falls, et al., duplicate databases are updated to reflect current changes entered by the user. The purpose of the update is to keep the database information identical in each platform. They are not updated with information to be fed to the user which is generated based on the user's interest and preferences and those of his gift recipients. Further, there is no suggestion in Falls, et al., to combine the database updating function with a product presentation software. Thus, there is no suggestion to combine Falls, et al., with Robertson. Falls, et al., is complete as it is, and is provided to synchronize information in databases between the system and computers which are disconnected from the system.

29. The Examiner has rejected claim 3 under 35 U.S.C. §103(a) over Robertson in view of Woolston, U.S. Pat. No. 6,202,051. Claim 3 adds a feature to the capabilities described in claim 1, that feature being responding to product postings in the form of an auction.

30. Woolston is a patent for an on-line auction which appears to be an on-line auction as exemplified by the famous on-line auction, Ebay. The Examiner states that combining the on-line auction capability of Woolston with the gift registry patent of Robertson, is basically equivalent to claim 3. However, there is nothing in the Woolston patent to indicate any desirability or capability of linking with a gift registry, and further, the gift registry of Robertson is not at all analogous to the system of the invention which is a system which acts as a personal assistant to a subscriber. The personal assistant function of this system comes in play when products are presented based on a user's interest and preferences, for himself or for people on his gift list. There is nothing in Robertson or Woolston, or the combination of the two to suggest this capability.

31. The Examiner has rejected claims 8-9 and claim 13 under 35 U.S.C. over Robertson in view of Slotznick, U.S. Pat. No. 5,983,200. Slotznick discloses an intelligent agent to which selected tasks may be delegated, and which will carry out those delegated tasks without approval of the user. Under Slotznick, payment and delivery are specified for future occurrences and evokes the system of Slotznick and the information it learns is equivalent to programs which learn log on and password names, addresses, and other repeatedly used information. There is nothing in Slotznick to indicate that it would suggest products for the purchaser to consider based on the user's preferences or interests, or those of his designated recipients. Three examples are illustrated in Slotznick to exemplify the operation of the system. The first example is exemplified by the statement "send flowers to Jim Smith and his wife on their anniversary." This instruction authorizes a future act to perform a specific task. Example 2 is "ship piston rings to Osaka Motors by next Thursday." This example is another version of an authorized activity to take place before a certain date. The other examples are "make airplane reservations for Cairo for Easter weekend," and "plan dinner for 6 with a fish entrée and pasta side-dish, and limit the salt and cholesterol."

32. None of these are equivalent to the product presentation system of the present invention. Combining the system of Slotznick with that of Robertson does not make a system equivalent to the current invention, because a gift registry of Robertson is strictly a recordation of user selected items in a gift registry equivalent to a department store gift registry for weddings. There is nothing in Robertson that would approximate the system of the invention in which a range of product offerings are presented to users based on preferences and interests.

33. The Examiner has rejected claims 10-12 and 14-18 under 35 U.S.C. §103(a) over Robertson combined with Slotznick and Falls, et al. These patents have been discussed above, and do not encompass or approximate this system of the invention or any equivalent to it. There is just no suggestion in any of these patents for them to be combined together for one thing, and even combined together, they do not perform the activities of the invention.

34. The Examiner has rejected claim 19 under 35 U.S.C. §103(a) over Robertson combined with Slotznick, Falls, et al., and Woolston. Each of these patents has been described above. This rejection has two flaws. There is no suggestion in any of these inventions to combine with other inventions to achieve the purpose of the current invention. Furthermore, even if they were combined, none of these patents have the basic functionality of the current invention.

35. The Examiner notes that Slotznick in Col. 18, Lines 36-58 discloses an information gathering system for gift profiles. This text in Slotznick cited by the Examiner is a description of how the first embodiment of the invention would work. That embodiment was "send flowers to Jim Smith and his wife on their anniversary." Accomplishing this task is described in Slotznick in Col. 18 starting at Line 7. In this example, the user has already chosen the type of gift, and that is going to be flowers. After entering information about whom the recipients are going to be

("Jim Smith and his wife"), the device may automatically complete the name. The user then enters the occasion for the gift (Col. 18, Lines 47-48) and lastly, the system can enter the address automatically and then select the flowers, as described in Col. 18, Lines 36-58.

36. This procedure is different than presenting the user with a number of options relative to an event such as the anniversary of Jim Smith and his wife. With the system of the current invention, the user could be prompted with a range of products which match the general preferences and interests of Jim Smith and his wife. These could include tickets to the opera, flowers, jewelry, articles of clothing, and any number of items which meet general characteristics specified as gift possibilities or areas of interest for Jim Smith and his wife. The system of Slotznick does not provide that kind of product presentation format. By contrast, the current invention puts all of these things together into an integrated system for product presentation and gift reminders.

CONCLUSION

Applicant submits that this application is now in full condition for allowance, which action Applicants respectfully solicit. If the Examiner feels it would advance the application to allowance or final rejection, she is invited to telephone the undersigned at the number given below.

DATED this 19th day of December 2005.

Very respectfully,

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